

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RAJESH B PAREKH, ANTHONY H. MERRY,  
and JAMES BRUCE

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Appeal No. 95-1881  
Application 08/032,166<sup>1</sup>

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HEARING: January 14, 1999

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Before GRON, WEIFFENBACH, and ELLIS, Administrative Patent  
Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 from an

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<sup>1</sup> Application for patent filed March 12, 1993. According to applicants, this application is a continuation of U.S. Application 07/719,288, filed June 21, 1991, abandoned.

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examiner's rejections of Claims 1, 2, 4, and 8 through 24, all claims pending in this application.

Claims 1, 2, 4, and 8 through 24 stand finally rejected (1) under 35 U.S.C. § 112, first paragraph, for noncompliance with its description requirement; (2) under 35 U.S.C. § 112, first paragraph, for noncompliance with its enablement requirement; and (3) under 35 U.S.C. § 103 as being unpatentable in view of the teaching of Montreuil et al. (Montreuil), Carbohydrate Analysis - A Practical Approach, IRL Press,

pp. 144-152 (1986). Representative Claim 1 reads:

1. A method for releasing an O-glycan from a glycoconjugate which method comprises

reacting said glycoconjugate with a hydrazine reagent,  
said glycoconjugate being essentially salt-free and essentially anhydrous and said hydrazine reagent being essentially anhydrous, and

controlling the time and temperature conditions under which the glycoconjugate is subjected to the influence of the hydrazine reagent within a range, according to first-order kinetics, corresponding to about 55°C to about 75°C at 8 hours so as to release O-glycans from the glycoconjugate recoverable in substantially unreduced and intact form.

We reverse all the examiner's rejections, essentially for

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reasons stated in appellants' Appeal Brief.<sup>2</sup> In our view, the examiner has not satisfied the PTO's initial burden to adequately explain: (1) why persons having ordinary skill in the art would not have recognized from the specification, especially Figure 3, that applicants invented the claimed method for releasing an O-glycan by reacting a glycoconjugate with a hydrazine reagent at "about 55°C to about 75°C at 8 hours"; (2) why the specification would not have enabled persons skilled in the art to make and use the method claimed wherein the hydrazine reagent is "a hydrazine-containing compound" without undue experimentation; and (3) why the method claimed would have been obvious to a person having ordinary skill in the art in view of Montreuil's teaching.

REVERSED

Teddy S. Gron )  
Administrative Patent Judge )  
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<sup>2</sup> At oral argument, counsel for appellants noted Parekh et al., U.S. Patent 5,539,090, patented July 23, 1996, from Application (continued...) 08/195,761, filed March 12, 1993, as a continuation of Application 07/719,287, filed June 21, 1991, abandoned.

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	Cameron Weiffenbach	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Joan Ellis	)	
	Administrative Patent Judge	)	

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Nixon & Vanderhye  
1100 North Glebe Rd.  
8th Floor  
Arlington, VA 22201-4714